

**REMARKS**

Claims 1-18 are all the claims pending in the application.

As a preliminary matter, the drawings are objected to under 37 C.F.R. § 1.83(a) because the Examiner alleges that the drawings fail to show every feature of the invention specified in the claims. Applicants submit Fig. 8 which shows a saw-tooth shaped irregularity. Applicants submit that the Fig. 8 does not add new matter because the original specification discloses “saw-tooth irregularity” and one skilled in the art would readily understand the term to disclose what is shown in Fig. 8. Applicants respectfully request entry of the new drawing.

Applicants amend page 11 of the specification to obviate the Examiner’s objection to the same.

Claims 1-18 are pending in the application. Claims 8-14 are withdrawn from consideration. Claims 15 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 2 and 15-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by Annoura et al. (U.S. Patent No. 6,258,410; hereinafter “Annoura”) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Annoura. Claims 3 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Annoura in view of DeTorre (U.S. Patent No. 5,365,821; hereinafter “DeTorre”) (previously of record). Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Annoura in view of Munier et al. (U.S. Patent No. 5,365,821; hereinafter “Munier”) (previously of record). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Annoura in view of Paavola (U.S. Patent No. 4,972,750;

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**AMENDMENTS TO THE DRAWINGS**

Applicant is enclosing herewith two (2) sheets of new drawings. The submitted drawings include FIG. 8.

The submitted drawings are believed to overcome the Examiner's objection in the Office Action mailed August 11, 2004.

Attachment: New Sheets of Fig. 8.

hereinafter “Paavola”) (previously of record). Claims 6 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Annoura in view of Takagi (U.S. Patent No. 6,033,057).

Applicants submit the following arguments in traversal of the rejections.

Rejection of Claims 15 and 18 under § 112, second paragraph

Applicants submit that claim 15 complies with § 112, second paragraph.

As for claim 18, Applicants submit that FIG. 8 discloses “irregularities having one of saw-tooth shape.” Therefore, claim 18 is definite and fully supported in the specification.

Rejection of Claims 1, 2 and 15-17 under § 102(e) by Annoura

Applicants submit that claim 1 is patentable because Annoura fails to disclose or suggest each and every element of the claims. For example, claim 1 recites:

a second beveled surface facing the workpiece and progressively spaced from said cutting edge away from the workpiece

On page 4 and in the annotated Fig. 15 of Annoura on page 9 of the Office Action, the Examiner asserts that the surface labeled as 72 is the claimed second beveled surface. To the contrary, surface 72 is not progressively *spaced away* from the workpiece, but rather progressively spaced *toward* the workpiece. In other words, the surface 72 is at an angle so that the surface 72 becomes progressively closer to the workpiece, the further the surface 72 is from the cutting edge.

In addition, claim 1 is patentable because Annoura fails to disclose or suggest the claimed first distance (CL) or the first angle ( $\theta$ ), in combination with other elements of the claim. In the Office Action, the Examiner incorrectly assumes that the claimed first distance (CL) is taught by

the distance “K” as shown on the annotated Fig. 15. The Examiner appears to extrapolate the distance K as being 87.5  $\mu\text{m}$  by comparing the length of the distance K with the distance Y, where distance Y is disclosed as being 25  $\mu\text{m}$ . Applicants submit that “[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP 2125. Nowhere in Annoura is there any mention of the drawings as being drawn to scale. In fact, measurements of the distance X (~2.5 mm) and the distance Y (~4 mm), where the distances X and Y are supposed to be equal (at 25  $\mu\text{m}$ ), indicate that Fig. 15 is not drawn to scale. In the Office Action, the Examiner also concedes that “the Figure not being drawn to scale.” Page 5, lines 2-3. Therefore, any measurements of the distance K cannot be relied on as teaching the claimed first distance (CL).

For the same reasons presented above, the Examiner’s measurements of the angle M in Fig. 15 as supposedly disclosing 8 degrees, cannot be properly relied on as teaching the claimed first angle ( $\theta$ ) of said first beveled surface from said severance plane set to a value which ranges from 0.8 to 14.

Moreover, Applicants request the Examiner to provide prior art which shows that the claimed first angle ( $\theta$ ) is obvious. The claimed first angle is one of the inventive aspects of the invention and “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03 A. Here, the

claimed first angle ( $\theta$ ) is not well known or even capable of being demonstrated as being well-known, and thus, is another patentable aspect of the invention.

For the above reasons, claim 1 is patentable over Annoura. Claims 2, 15, and 16, which depend from claim 1, are patentable for at least the reasons submitted for claim 1.

Claim 17 is patentable for reasons similar to those submitted for claim 1. Nowhere in Annoura is there any teaching or suggestion of a second beveled surface facing the workpiece and progressively spaced from said cutting edge away from the workpiece, in combination with other elements of the claim.

With respect to the following rejections:

Alternative Rejection of Claims 1, 2 and 15-17 under § 103(a) by Annoura

Rejection of Claims 3 and 7 under § 103(a) over Annoura in view of DeTorre

Rejection of Claim 4 under § 103(a) over Annoura in view of Munier

Rejection of Claim 5 under § 103(a) over Annoura in view of Paavola

Rejection of Claims 6 and 18 under § 103(a) over Annoura in view of Takagi

Applicants submit that Annoura is an improper § 103(a) reference. Annoura only qualifies as prior art under 35 U.S.C. § 102(e) and therefore, the alternative rejection of claims 1, 2, and 15-17, and the rejection of claims 3-7 and 18 under § 103(a) are not proper under 35 U.S.C. § 103(c). Accordingly, Applicants submit the common assignment data for Annoura (Date of Recordation: April 6, 1999, Reel No.: 009871; Frame No.: 0294) as ATTACHMENT I

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to traverse rejections under § 103(a). The assignment of the present application to the common assignee is recorded at Reel 011757, Frame 0482 (April 30, 2001).

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Paul F. Neils  
Registration No. 33,102

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
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# ATTACHMENT I



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## Patent Assignment Abstract of Title

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**Total Assignments: 1****Patent #:** 6258410      **Issue Dt:** 07/10/2001      **Application #:** 09235296      **Filing Dt:** 01/22/1999**Inventors:** YASUHIRO ANNOURA, TAKANORI MASUDA, KOICHIRO AONO, TSUTOMU KATO**Title:** METHOD AND APPARATUS FOR MANUFACTURING SENSITIZED PRINTING PLATE**Assignment: 1****Reel/Frame:** 009871/0294      **Recorded:** 04/06/1999      **Pages:** 2**Conveyance:** ASSIGNMENT OF ASSIGNEES INTEREST (SEE DOCUMENT FOR DETAILS).

<b>Assignors:</b> <u>ANNOURA, YASUHIRO</u>	<b>Exec Dt:</b> 03/06/1999
<u>MASUDA, TAKANORI</u>	<b>Exec Dt:</b> 03/06/1999
<u>AONO, KOICHIRO</u>	<b>Exec Dt:</b> 03/06/1999
<u>KATO, TSUTOMU</u>	<b>Exec Dt:</b> 03/06/1999

**Assignee:** FUJI PHOTO FILM CO., LTD.  
NO. 210 NAKANUMA, MINAMI-ASHIGARA-SHI  
KANAGAWA, JAPAN

**Correspondent:** SUGHRUE, MION, ZINN, MACPEAK & SEAS  
DARRYL MEXIC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, D.C. 20037-3202

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